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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT K. SAMSON

Appeal 2010-011604
Application 09/766,277
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
MEREDITH C. PETRAVICK, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Robert K. Samson (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 78-86 and 113-116. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We REVERSE.[1]

THE INVENTION

This invention is "a system and method for providing investment guidance and . . . for facilitating the selection of investment options such as mutual funds." Spec. 1:5-7.

Claim 78, reproduced below, is illustrative of the subject matter on appeal.

> 78. An investment guidance system for providing financial planning assistance, comprising:
>
> [A] means for receiving a financial goal from a user;
>
> [B] means for receiving one or more input decisions upon which the probability of achieving said financial goal is dependent, wherein one of the input decisions includes selecting an asset allocation based on investment risk;
>
> [C] means for determining the probability of achieving said financial goal;

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[1] Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed Mar. 8, 2010) and Reply Brief ("Reply Br.," filed Jul. 26, 2010), and the Examiner's Answer ("Ans.," mailed May 25, 2010).

[D] means for receiving an indication that said user has selected a target asset allocation investment plan in order to achieve said financial goal;

[E] means for receiving a request to rate a plurality of assets within a selected asset class;

[F] means for providing two or more criteria associated with said assets for said user to evaluate;

[G] means for determining a normalized value for each of said two or more criteria;

[H] means for receiving a relative weight of importance for said two or more criteria based on the user's personal investment preferences;

[I] means for determining a rating for each asset based on the normalized values and the relative weights assigned to said two or more criteria;

[J] means for ranking plurality of said assets based on said rating;

[L] means for receiving a request to execute a trade for one or more of the ranked assets in order to fulfill said target asset allocation investment plan; and

[M] means for executing said trade for one or more of the selected ranked assets.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Champion	US 5,126,936	Jun. 30, 1992
Giansante	US 6,275,814 B1	Aug. 14,2 001

The following rejections are before us for review:

1. Claims 78-86 and 113-116 are rejected under 35 U.S.C. §103(a) as being unpatentable over Giansante and Champion.

ISSUE

The issue is whether the Examiner established a prima faice showing of obviousness in rejecting claim 78 under 35 U.S.C. §103(a) as being unpatentable over Giansante and Champion.

FINDING OF FACT

We find that the following enumerated finding of fact (FF) is supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Giansante's column 6, line 36-42 states:

> 2. The process of claim 1 further comprising the step:
> k) adjusting the weights of the assets in each efficient portfolio to optimize the level of industry sector and investment style diversification in the portfolio, so as to maintain the portfolio at a position on or near the efficient frontier and at the desired risk level.

PRINCIPLES OF LAW

A claim limitation that includes the term "means" is presumed to be intended to invoke means-plus-function treatment, i.e., treatment under 35 U.S.C. §112, 6th paragraph. *Rodime PLC v. Seagate Tech.*, Inc., 174 F.3d 1294, 1302 (Fed. Cir. 1999).

35 U.S.C. 112, sixth paragraph states: "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

> The first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. *Budde v. Harley-Davidson, Inc.,* 250 F.3d 1369, 1376 (Fed.Cir.2001). "The court must construe the function of a means-plus-function limitation to include the limitations contained in the claim language, and only those limitations." *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.,* 296 F.3d 1106, 1113 (Fed.Cir.2002).... The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function. "Under this second step, 'structure disclosed in the specification is "corresponding" structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.'" *Med. Instrumentation & Diagnostics Corp. v. Elekta AB,* 344 F.3d 1205, 1210 (Fed.Cir.2003) (quoting *B. Braun Med. Inc. v. Abbott Labs.,* 124 F.3d 1419, 1424 (Fed.Cir.1997)).

Golight Inc. v. Wal-Mart Stores Inc., 355 F.3d 1327, 1333-34 (Fed. Cir. 2004).

ANALYSIS

We are persuaded by the Appellant's argument on pages 19-26 of the Appeal Brief and pages 4-6 of the Reply Brief that the Examiner erred in

rejecting claim 78 under 35 U.S.C. § 103(a) as being unpatentable over Giansante and Champion. The limitations marked F-I above are at issue. *Id.*

We find that the Examiner fails to establish a prima facie showing of obviousness. Limitations F-I are written in means-plus- function format and presumably invoke 35 U.S.C. § 1 12, sixth paragraph. However, the Examiner provides no analysis[2] identifying the corresponding structure in the Specification for each limitation F-I nor does the Examiner provide any analysis as to what would constitute an equivalent of the corresponding structure.

In the rejection, the Examiner cites to "column 6, lines 36+"[3] of Giansante as teaching each of the limitations (Ans. 4), but provides no other explanation. Likewise, in their response, the Examiner asserts that the step of adjusting weights of assets described in lines 36-42 of column 6 (FF 1), is "functional equivalent" of the "applicant's invention" (Ans. 8), but again

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[2] We note that the Examiner states: "It is respectfully maintained that there is an uncertainty from the applicant's specification as to the corresponding structure to perform the various functions the applicant maintains as not found in Giansante reference." Ans. 8. However, the Examiner does not provide any further explanation and has not rejected claims under 35 U.S.C. § 112, second paragraph as indefinite. "If there is no structure in the specification corresponding to the means-plus-function limitation in the claims, the claim will be found invalid as indefinite." *Biomedino, LLC v. Waters Techs. Corp.,* 490 F.3d 946, 950 (Fed.Cir.2007). We note that the Appellant contests this assertion in the Appeal Brief. *See* App. Br. 26-30. *See also* Reply Br. 6-8.

[3] We note that in their response, the Examiner expands their citation to encompass lines 7-67 of column 6 of Giansante, but only references the step of adjusting weights of the assets recited in lines 36-42 in their argument. Ans. 8.

fails to provide any other explanation. We agree with the Appellant's argument on pages 19-26 of the Appeal Brief and pages 4-6 of the Reply Brief that the cited portions of Giansante[4] fail to teach the limitations at issue, when properly construed according to 35 U.S.C. 112, 6th paragraph.

We find that the Examiner failed to establish a prima facie showing of obviousness. Accordingly, the rejection of claim 78, and claims 79-86 and 113-116, dependent thereon, under 35 U.S.C. § 103(a) as being unpatentable over Giansante and Champion is reversed.

DECISION

The decision of the Examiner to reject claims 78-86 and 113-116 is reversed.

REVERSED

MP

[4] In their response, the Examiner argues that the Appellant is engaging in a piecemeal analysis of the references (Ans. 8). However, in the rejection the Examiner only cites to Giansante, and not Champion, to teach the limitations at issue. Ans. 4.